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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/446,511	12/27/1999	RUDOLF RITTER	PM 265420	2426

909 7590 04/03/2003

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EXAMINER

HUSEMAN, MARIANNE

ART UNIT	PAPER NUMBER
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3621

DATE MAILED: 04/03/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/446,511

Applicant(s)

RITTER ET AL.

Examiner

M. Huseman

Art Unit

3621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 March 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 and 23-26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-21 and 23-26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Status of Claims

1. Claims 1 – 21 and 23 – 26 remain in this case; claim 22 has been cancelled.

Response to Arguments

2. Applicant's arguments with respect to claims 1 – 21 and 23 - 26 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1 – 21 and 23 – 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Arai (Unexamined Japanese Patent No. 8-249530) in view of Vazvan (WO 96/13814) and O'Mahony et al, "Electronic Payment Systems".

Regarding claims 1, 2, 7, 16 – 18, 21 and 23

Arai, figure 5, teaches an automatic vending system utilizing a mobile telephone such that Applicants' step of transmitting customer identification, via a contactless interface reads on the call originating source identification information or individual identification information, Applicants' step of checking, by the terminal, customer identification reads on the controller (located at the terminal) determining whether the mobile telephone number (customer identification information) is registered, paragraph [0024], Applicants' step of transmitting a transaction amount reads on the value of the selected commodity, Applicants' step of charging reads on the billing information stored at the terminal in the storage part, element 22, paragraph [0044], and Applicants' step of preparing, in said terminal, a transaction document and transmitting the transaction document to a telephone firm (service center), reads on paragraphs [0013] and [0014].

Although Arai does not teach using a removable identification module, Vazvan discloses a wireless telephone debit card removable from a radio telephone and that the card can be increased via wireless communication. Therefore, it is considered that it would have been obvious to one of ordinary skill in the art at the time of the invention to

modify Arai to include a removable identification module/card as taught by Vazvan as the module/card may then be used with other module/card reading systems besides the telephone.

Further, although Arai does not teach electronically signing the document, O'Mahony et al, pages 113 – 116, teach the particulars of a merchant capturing payment from a payment server wherein cryptographic protocols are used to securely transmit transaction information when communicating via the internet. More particularly, Applicants' step of electronic signing, reads on the merchant signing a capture request (can be transmitted in batch form – claim 7) wherein the request contains transaction data, figure 4.39 (Capture Token – claim 22), Applicants' step of checking the signature reads on the payment server verifying the request and Applicants' step of paying reads on the payment to the merchant account the amount of the purchase, bottom of page 115 to first paragraph of page 116 (claim 2). Therefore, it is considered that it would have been obvious to one of ordinary skill in the art at the time of the invention to utilize cryptographic techniques for communicating transaction information over a public network, as is taught by O'Mahony et al, as utilizing those techniques are a well-known secure method of communicating transaction information.

Regarding claim 3:

O'Mahony et al, pages 102 – 103, illustrate the use of a merchant, customer, acquirer (clearing unit) and bank for card transactions. Purchasing methods have long been known to use acquirers (clearing units, archives, payment gateways, third parties, certification authorities etc...) and servers (banks, financial institutions etc...) as a means for conducting transactions between a merchant and a customer. Therefore, it is considered that it would have been obvious to one of ordinary skill in the art to use a clearing unit as well as a server as taught by O'Mahony et al in the system taught by Pitroda as a clearing unit would free up server usage and is usually less expensive as a result.

Regarding claims 4 - 6:

O'Mahony et al, page 109, teach the use of SET protocol wherein according to an aspect of the SET protocol, the customer (identification module) sends a digital

signature to the merchant who passes it on to the acquirer/service center as a means of informing the acquirer that the cardholder consents to the particular transaction.

Regarding claims 8 – 10, 24 and 25:

While none of the references disclose black lists, a black list is considered to be an old and well-known technique for banks and retailers to keep track of cards (whether they are smart cards, debit cards, wallets or credit cards) that are lost or stolen or misused and to prevent those cards from being used in transactions. Therefore, it is considered that it would have been obvious to one of ordinary skill in the art at the time of the invention to utilize checking "black lists" as money could be lost to everyone legitimately concerned in the transaction.

Regarding claim 11:

Vazvan teaches that the transaction card is a SIM card.

Regarding claims 12 - 15:

Although Vazvan does not specifically teach that the SIM is a transponder or communicates via an integrated inductance or infrared, these are all old and well known techniques for communication. Therefore, it is considered that it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the combined teachings of Arai and Vazvan to include any communication technique desired as the device will have more utility in having more choices for communication.

Regarding claim 19:

O'Mahony et al teach various electronic payment systems wherein it is disclosed that some item information (voucher) transmitted between entities do not need to be encoded while for other items of information (within the same data transmission) are proper to be encoded. See page 81, Section 4.6.4 "CyberCash messages" of O'Mahony et al. Therefore, it is considered that it would have been obvious at the time of the invention to save processing time of the receiver of the items of information if only the information requiring privacy from eavesdroppers, etc... were to be encoded and not, for instance, the order information or client/transaction ID.

5. Claim 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over Arai in view of Vazvan and O'Mahony et al as applied to claim 1 above, and further in view of Yacobi.

Although none of the references, Arai, Vazvan nor O'Mahony et al specifically teach the encryption method claimed, Yacobi, column 9, lines 47 – 51, teaches the combined usage of symmetrical and asymmetrical encryption for transmission of monetary information wherein the session key (symmetrical) is encrypted with the recipient's public key (asymmetrical). Therefore, it is considered that it would have been obvious to one of ordinary skill in the art at the time of the invention to use this type of encryption as it is believed to be one of many methods for the secure transmission of information.

6. Claim 26 is rejected under 35 U.S.C. 103(a) as being unpatentable over Arai in view of Vazvan and O'Mahony et al as applied to claim 1 above, and further in view of Pitroda '038.

While Vazvan does not disclose a memory on the SIM card for recording transactions, but rather a printer for printing out such information, Pitroda teaches an identity/UET card wherein this information is kept, element 410. Therefore, it is considered that it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the card of Vazvan to include a transaction record memory so that this information does not have to be printed out on each and every occasion but could be kept in the card for instances, for example, when paper is not available for printing that information. Further, Pitroda teaches that communication between the service center and the UET card is possible, column 16, lines 52 – 54. Arai's system also has the ability for communication between the mobile phone and service center.

Conclusion

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Martineau and Schilling each teach a prepaid smart card in a GSM/radio based wireless telephone network.


8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to M. Huseman whose telephone number is 703-605-4277. The examiner can normally be reached on Monday - Friday, 6:30 AM - 3:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell can be reached on 703-305-9768. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-7687 for regular communications and 703-305-7687 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.


JAMES P. TRAMMELL
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600


M. Huseman
Examiner
Art Unit 3621

mh
March 26, 2003